

## **REMARKS**

Reconsideration and allowance of this application are respectfully requested in light of the above amendments and the following remarks.

Claim 79 is pending in the present application.

### **Formal Matters**

The Office Action has acknowledged consideration of the Information Disclosure Statement filed May 11, 1999.

### **Objections**

It is respectfully submitted that the above amendments to the specification overcome the objections stated in the Office Action for the following reasons.

#### **Trademark Usage**

The Office Action's comments with respect to trademark usage have been noted. To the extent reasonably practical, it is believed that the trademarks have been capitalized and used in an appropriate trademark sense in association with a modified noun or with generic terminology.

#### **Drawings**

The Office Action objected to the drawings because they lacked programs 44. A proposed change to FIG. 1A is submitted herewith to collectively label as programs 44 the already labeled programs 44A (REQUI), 44B (Inventory Sourcing), 44C (Requisition Maintenance), 44D (Order Header, and 44E (Customer Variable).

Applicant thanks the Examiner for noting that the drawings lack reference number 81 as disclosed at page 33, line 3. Since reference number 81 merely refers to the message screen illustrated in Appendix X, this reference number has been deleted from the application.

It is respectfully submitted that the proposed change to FIG. 1A and the deletion of the

reference number "81" from the specification, together overcome the objections to the drawings stated in the Office Action.

### Objections To The Specification

1. Continuing data on page 1

The continuing data on page 1 has been updated to state that the first referenced application issued into U.S. Patent No. 6,055,516 on April 25, 2000.

2. Reference to Application Serial No. 08/042,168

The application data on pages 1 and 12 has been updated to state that the referenced application has now issued into U.S. Patent No. 5,712,989, which issued on January 28, 1998.

3. Objection to the Appendices

In response to the problems with the margins of appendices I through X (1-10), attached hereto are substitute pages 40 through 49, wherein the text on the pages has been reduced in size to correspond to the margin requirements of 37 C.F.R. §1.52(b).

### Rejection of Claim 79 Under 35 U.S.C. §102(b) Over Dworkin (U.S. Patent No. 4,992,940)

#### The Office Action Position

With regard to claim 79, the Office Action alleges that Dworkin discloses a centralized ordering system that includes a database comprising a number of different categories (i.e., first criteria) that are collections of similar/equivalent products from a number of different vendor catalogs. These categories of various products are available to the user for selecting various related products. Based on the user's search request, (i.e., second criteria) the system of Dworkin searches through the vendor/product database for matching categories and products. The results of the search i.e., matching products, are returned to the user. Based on the returned matching product information, the user may create one or more requisition orders necessary to purchase the selected

items according to the vendor's requirements for a requisition order (emphasis added).

### Applicants' Traversal

A requisition and a purchase order are terms of art and refer to a listing of required items and an order to purchase one or more items. While the requisition may specify possible and preferred vendors/suppliers for each item listed, the purchase order is addressed to a single vendor/supplier. The requisition identifies needed items and candidate vendors/suppliers and the purchase order authorizes a single vendor/supplier to provide one or more items, usually at a pre-determined price. As commonly used by those skilled in the art, requisition and purchase order are not one and the same. The requisition only identifies needed items but the purchase order authorizes a vendor/supplier to supply an item or items to satisfy a need. Thus, a requisition, as used by those skilled in the art, potentially list items from the same/different categories and different vendors/suppliers for each item.

Dworkin does not disclose accumulating user selections in a requisition, as does the instant claimed invention (claim 79 and page 5, lines 11-30). On the contrary, Dworkin discloses soliciting selection criteria for a single product type/category (see FIGs. 3-5) from a user, searching a centralized database for all items matching the user-supplied criteria and presenting the results to the user as a product set (see FIG. 6) for further action. The user can then take the action "Investigate Product" and be presented with vendors/suppliers (FIG. 7) of the product selected for investigation (column 2, lines 34-40). The user may choose to order a specific product contained in a retrieved and displayed product set from a specific vendor (column 8, lines 9-37) of that product. Thus, there is no teaching by Dworkin of creating requisition orders, as alleged in the Office Action (page 3, item 6.1.1) but only of creating an order for an item. There is also no teaching by Dworkin of

accumulating items for the same vendor on a single order.

By contrast, as illustrated in FIG. 1C, the instant invention claims means for building a requisition that includes data relating to selected matching items (instant claim 79) and discloses that these means include a Requisition Item Table 46, some of which is displayed on the screens shown in Appendices II, VIII and IX, and which is separate from Order Lists Table 48. A single requisition, according to the present invention, can contains multiple selected items, i.e., stock numbers of multiple items (page 12, line 33 through page 13, line 7) which can be sourced to different vendors/suppliers and which can each be of different product types/categories (see Appendix IX which is a requisition for Acetone, a Beaker and a Programmable Oven that fall into different categories of products). In the present invention, creating a requisition is separate from sourcing and purchasing (see, e.g., page 16, line 26 *et. seq.*).

It is well-settled that anticipation requires a single prior art reference in which all of the same elements are found in exactly the same situation and united in the same way to perform the identical function. E.G. *Saf-Gard Products, Inc. v. Service Parts, Inc.*, 532 F.2d 1255, 1270 (9<sup>th</sup> Cir. 1976), cert. denied, 429 U.S. 898 (1976); *Roberts v. Sears, Roebuck & Co.*, 723 F.2d 1324, 1332 (7<sup>th</sup> Cir. 1983) (quoting *Illinois Tool Works, Inc., v. Sweetheart Plastics, Inc.*, 436 F.2d 1180, 1182-3 (7<sup>th</sup> Cir.), cert. dismissed, 403 U.S. 942 (1971)).

Since the elements of instant claim 79 are not depicted in the same situation and united in the same way to perform the identical function as those of Dworkin, Dworkin does not anticipate instant claim 1, and the rejection should be withdrawn.

**Non-statutory Double Patenting Rejection of Claim 79 Over Claims 14-30 & 40-45 of U.S.**

**Patent No. 6,023,683**

Attached is a copy of an assignment of the instant application, Serial No. 09/532,557 and

statutory double patenting ground provided the conflicting application and patent are shown to be commonly owned (37 C.F.R. 1.130(b)).

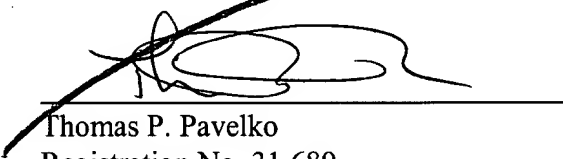
Accordingly, it is respectfully submitted that the non-statutory double patenting rejection of instant claim 79 has been overcome and should be withdrawn.

**Conclusion**

In light of the foregoing it is respectfully submitted that pending claim 79 is directed to allowable subject matter, all objections and rejections stated in the outstanding Office Action have been overcome, and that the present application is now in condition for allowance. A notice of allowance is respectfully solicited.

If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to telephone the undersigned at the local Washington, D.C. telephone number below.

Respectfully submitted,

  
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Thomas P. Pavelko  
Registration No. 31,689

Date: July 25, 2001

Enclosures:

Terminal Disclaimer  
Letter to the Official Draftsman with amended Fig. 3  
Substitute Pages for Appendices I to X (1-10)

TPP/NOW/att

ATTORNEY DOCKET NO. TPP 31400DIV

STEVENS, DAVIS, MILLER & MOSHER, L.L.P.  
1615 L Street, N.W., Suite 850  
P.O. Box 34387  
Washington, D.C. 20036  
Telephone: (202) 785-0100  
Facsimile: (202) 408-5200

THE APPLICANT HEREWITH PETITIONS  
THE PTO TO EXTEND THE TIME FOR  
RESPONSE AS REQUIRED TO MAKE THE  
ATTACHED DOCUMENT TIMELY FILED.  
PLEASE CHARGE THE COST THEREOF  
TO DEPOSIT ACCOUNT 19-4375

STEVEN DAVIS MILLER & MOSHER, L.L.P.

Letter to the Official Draftsman with amended Fig. 3  
Substitute Pages for Appendices I to X (1-10)

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ATTORNEY DOCKET NO. TPP 31400DIV

STEVENS, DAVIS, MILLER & MOSHER, L.L.P.  
1615 L Street, N.W., Suite 850  
P.O. Box 34387  
Washington, D.C.  
Telephone: (202) 785-0100  
Facsimile: (202) 408-5200



Version 1.0 Markings To Show Changes Made

IN THE DRAWINGS:

A letter to the Official Draftsperson with proposed changes to FIG. 1A indicated in red, is submitted herewith.

IN THE SPECIFICATION:

Page 1, the paragraph inserted before the first line as a result of Section 8, entitled "Relate Back", of the new application transmittal that was filed on January 20, 1999, please replace with the following:

This application claims the benefit of U.S. Application No. 09/234,366 filed on January 20, 1999, and which is now U.S. Patent No. 6,055,516 which is a continuation of U.S. Application No. 08/288,577 filed on August 10, 1994, and which is now U.S. Patent No. 6,023,683.

Page 1, last partial paragraph through page 2, first partial paragraph, please replace with the following:

There are a number of known requisition purchasing systems that manage and process requisitions and purchase orders. One such system is the Fisher Scientific Requisition and Inventory Management System ("Fisher RIMS"), described [in co-pending patent application Serial No. 08/042,168, filed April 2, 1993] U.S. Patent No. 5,712,989, issued on January 28, 1998 and assigned to Fisher Scientific Company of Pittsburgh, Pennsylvania, the disclosure of which is incorporated herein by reference. As its title suggests, fisher RIMS can also manage inventory. In the Fisher RIMS system, requisition records are created from a real-time interaction between a host computer (generally a mainframe) and a local computer (generally at a customer site), with each computer using data from its own respective database of inventory in conjunction with information entered by a customer service representative operating the local computer. By accessing its respective database,

each computer can build and transmit to the other computer communications blocks of data relating to a particular requisition of an item in inventory (or to the management of the inventory itself). The other computer can then use the received data to continue processing of the requisition. Thus, requisition records are created from a real-time interaction between the host and local computers, with each computer using data from its respective database in conjunction with information entered by a customer service representative operating the local computer.

Page 12, last partial paragraph through page 13, first partial paragraph, please replace with the following:

Preferable, a user will start the electronic sourcing system 5 from Fisher RIMS system 40. Requisitioning on Fisher RIMS system 40 in context of the electronic sourcing system 5 of the present invention is illustrated in pertinent part in FIG. 2 (and is fully described in [Application Serial No. 08/042,168] U.S. Patent No. 5,712,989 . As data (e.g., Account Number, Requisition Number and Stock Numbers) associated with a single requisition are entered through the various data screens on local computer 20, that computer creates a set of Requisition Tables (including a requisition Item Table 46, shown in FIG. 1C) FOR THAT PARTICULAR REQUISITION. THE Requisition Tables are stored in Requisition databases 42A (shown in FIG. 1A), and can be accessed by local computer 20 using the Requisition Number to find the desired table.

Page 32, last partial paragraph, through page 33 first partial paragraph, please replace with the following:

Referring again to FIG. 2, a user is able to view the messages returned by pressing the ALT F11 function keys in REQI program 44A and its associated Requisition Management screen 110 in Fisher RIMS system 40. After the ALT F11 keys have been pressed, REQI program 44A will link to ESMV program 112 via XCTL link 111 for displaying the message log created. ESMV program



112 is a function of Fisher RIMS system 40. ESMV program 112 allows the user to page through the messages created and then to return to Requisition Management screen 110. A sample ESMV message screen [81] associated with ESMV program 112 is shown in Appendix X.